

Remarks

In reply to the above-identified Office Action, Applicant amends the application and seeks reconsideration thereof. In this reply, Applicant amends claims 8-11. Applicant does not cancel or add any new claims in this reply. Accordingly, claims 1-11 are pending.

I. Claims Rejected under 35 U.S.C. § 103

The Examiner rejects claims 1-5 and 7 under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 2,820,638 issued to Morrison ("Morrison") in view of Applicant's alleged admission. Applicant respectfully traverses the rejection.

To render a claim obvious, the relied upon references must teach or suggest each element of the claim such that the invention as a whole would have been obvious at the time of the invention to one skilled in the art. Regarding claim 1, among other elements, claim 1 defines a putter club head comprising a hosel including a leg portion, said leg portion "having a predetermined forward slant angle with respect to [a] body axis such that said leg portion remains concealed, when viewed from directly above [a] club head body, within a range of adjustment of [a] lie angle." Applicant submits Morrison in view of Applicant's alleged admission fails to teach or suggest at least these elements of claim 1.

In making the rejection, the Examiner characterizes Morrison as showing a putter club head having a "leg portion configured to deform plastically to allow adjustment of the lie angle and having a predetermined forward slant angle with respect to the body axis such that the lower shaft portion inherently remains concealed when view [sic] from directly above the club head body within a range of adjustment of the lie angle (See Figures 1 and 4)." Paper No./Mail Dated 20040830, page 2. Applicant has reviewed Morrison in its entirety and respectfully disagrees with the Examiner's characterization of Morrison.

Morrison teaches, "a golf club having a mark on the top of the club head and having a lower portion of the shaft, or shank portion, inclined from the vertical whereby the player can assume the proper stance by aligning his eyes with the shank to automatically bring his head over the mark on the club head in the proper position for addressing the ball." Morrison, Column 1, lines 32-38 (emphasis added). In his disclosure, Morrison states:

The form of the invention illustrated in Figure 4 is especially well adapted for sighting along the shank portion or shank 4' of the shaft 3' to correctly position the golfer's head. ... The shank portion 4' shown is, however, for the most part rectangular and has a flat surface or sighting portion 23' facing the toe of the head 2'.

The sighting portion 23' of the shank 4' preferably forms an angle α of about 87° to 89° with the upper surface 10' of the club head when the latter is constructed so that on assuming its natural lie, the upper surface is in a horizontal plane. Morrison, Column 3, lines 25-28 and lines 30-38 (emphasis added).

Therefore, Applicant submits Morrison teaches a golf club putter having a shaft having a shank portion (reference numbers 4 and 4' in Figures 1 and 4, respectively), the shank portion having a sighting portion (reference numbers 23 and 23' in Figures 1 and 4, respectively) facing the toe of the putter, wherein the sighting portion helps the golfer to correctly position his head. Morrison refers to the portion of the shaft as a "sighting portion" which portion is used to align the golfer's head when using the putter. "Sighting," as used by Morrison, requires that the portion be visible to the golfer when using the putter so that the golfer is able to correctly align his head. Thus, the sighting portion must be visible to the golfer when the golfer is directly above the golf club head and cannot read on the elements of a hosel including a leg portion, said leg portion "having a predetermined forward slant angle with respect to [a] body axis such that said leg portion remains concealed when viewed from directly above [a] club head body " as defined in claim 1 since the shank is not concealed when a golfer's eyes are directly above the putter. Therefore, Morrison fails to teach or suggest each of the elements of claim 1.

The Examiner relies on Applicant's alleged admission to cure the defects of Morrison, however, Applicant submits the alleged admission, even if made (which Applicant submits he did not make), fails to cure the defects of Morrison. In characterizing the alleged admission, the Examiner claims Applicant suggested "that a leg and boss are common for constructing hosels within the art." The Examiner does not allege Applicant admitted that it is common for hosels to have a predetermined forward slant angle with respect to a body axis such that said leg portion remains concealed when viewed from directly above a club head body. Applicant submits that it is NOT common for hosels to include such elements. Therefore, Applicant's alleged admission, even if made, fails to cure the defects of Morrison.

The failure of Morrison combined with the prior art to teach or suggest each of the elements of claim 1 is fatal to the obviousness rejection. Therefore, claim 1 is not obvious over the prior art. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 1.

Regarding the rejection of claims 2-5 and 7, these claims each directly or indirectly depend from claim 1 and contain all of the elements thereof. Therefore, Applicant submits claims 2-5 and 7 are not obvious over the prior art at least for the same reasons of claim 1. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 2-5 and 7.

The Examiner rejects claim 6 under 35 U.S.C. 103(a) as being obvious over Morrison in view of Applicant's alleged admission and in further view of Japanese Publication JP 02-068080 submitted by Chuzo ("Chuzo"). Applicant respectfully traverses the rejection.

In making the rejection, the Examiner characterizes Morrison and the alleged admission similar to the characterization above. Applicant discussed Morrison and the alleged admission above and submits the discussion above regarding this combination failing to teach or suggest at

least a leg portion, said leg portion including "a predetermined forward slant angle with respect to [a] body axis such that said leg portion remains concealed when viewed from directly above [a] club head body" is equally applicable to claim 6 since claim 6 depends from claim 1 and contains all of the elements thereof. Therefore, Morrison and the alleged admission fail to teach or suggest each of the elements of claim 6.

The Examiner relies on Chuzo to cure the defects of Morrison and the alleged admission, however, Applicant submits Chuzo fails to cure such defects. In making the rejection, the Examiner characterizes Chuzo as showing "a putter having a hosel with a horizontal portion 2 (See Abstract and Figure 3)." Paper No./Mail Dated 20040830, page 3. The Examiner does not cite Chuzo as teaching or suggesting a leg portion, said leg portion "having a predetermined forward slant angle with respect to [a] body axis such that said leg portion remains concealed when viewed from directly above [a] club head body." Moreover, Applicant has reviewed Chuzo in its entirety and cannot discern any sections of Chuzo that teach or suggest such elements. Therefore, the combination of Morrison, Applicant's alleged admission and Chuzo fails to teach or suggest each of the elements of claim 6.

The failure of Morrison combined with Applicant's alleged admission and Chuzo to teach or suggest each of the elements of claim 6 is fatal to the obviousness rejection. Therefore, claim 6 is not obvious over the prior art. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 6.

The Examiner rejects claims 8-11 under 35 U.S.C. 103(a) as being obvious over The Modern Guide to Golf Clubmaking authored by Jackson ("Jackson") in view of Applicant's alleged admission. Applicant amends claim 8.

Among other elements, amended claim 8 defines a method of customizing a golf putter comprising the steps of "adjusting [a] lie angle to [a] target lie angle by plastically deforming [a] leg portion such that said leg portion remains concealed, when viewed from directly above said club head body, within a range of adjustment of said lie angle." Applicant submits Jackson in view of Applicant's alleged admission fails to teach or suggest at least these elements of claim 8.

In making the rejection, the Examiner characterizes Jackson as showing "a method for customizing a golf club head comprising providing a golf club head including a club head body having a body axis wherein a shaft or shaft connecting portion is attached to the club head, determining a target lie angle, and adjusting the lie angle to the target lie angle by plastically deformation." The Examiner does not cite Jackson as showing a leg portion that remains concealed after adjustment of the lie angle within a range of adjustment. In addition, in reviewing Jackson in its entirety, Applicant is unable to discern any sections of Jackson showing such elements. Therefore, Jackson fails to teach or suggest each of the elements of claim 8.

The Examiner relies on Applicant's alleged admission to cure the defects of Jackson, however, Applicant addressed the alleged admission above and submits the discussion above regarding the alleged admission failing to teach or suggest a leg portion having a predetermined forward slant angle with respect to a body axis such that said leg portion remains concealed, when viewed from directly above a club head body, within a range of adjustment of a lie angle recited in claim 1 is equally applicable to similar elements recited in claim 8. Therefore, the combination of Jackson and the alleged admission fails to teach or suggest each of the elements of claim 8.

The failure of Jackson combined with the prior art to teach or suggest each of the elements of claim 8 is fatal to the obviousness rejection. Therefore, claim 8 is not obvious over

the prior art. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 8.

Regarding the rejection of claims 9-11, these claims each directly or indirectly depend from claim 8 and contain all of the elements thereof. Therefore, Applicant submits claims 9-11 are not obvious over the prior art at least for the same reasons of claim 8. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 9-11.

The Examiner rejects claims 1-5 and 7-11 under 35 U.S.C. 103(a) as being obvious over Morrison in view of Applicant's alleged admission and in further view of Jackson. Applicant respectfully traverses the rejection of claims 1-5 and 7 and amends claim 8.

In making the rejection, the Examiner characterizes Morrison, the alleged admission and Jackson similar to the characterizations above. Applicant discussed these references above and submits these references in combination fail to teach or suggest at least the elements of a leg portion having a predetermined forward slant angle with respect to a body axis such that said leg portion remains concealed, when viewed from directly above a club head body, within a range of adjustment of a lie angle for reasons similar to those discussed above. Therefore, the combination of Morrison, the alleged admission and Jackson fails to teach or suggest each of the elements of claims 1-5 and 7-11.

The failure of the combination of Morrison, the alleged admission and Jackson to teach or suggest each of the elements of claims 1-5 and 7-11 is fatal to the obviousness rejection. Therefore, claims 1-5 and 7-11 are not obvious over the prior art. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-5 and 7-11.

The Examiner rejects claim 6 under 35 U.S.C. 103(a) as being obvious over the combination of Morrison, the alleged admission, Jackson and Chuzo. Applicant respectfully traverse the rejection.

In making the rejection, the Examiner characterizes Morrison, the alleged admission, Jackson and Chuzo similar to the characterizations discussed above. Applicant discussed these references above and submits these references in combination fail to teach or suggest at least the elements of a leg portion having a predetermined forward slant angle with respect to a body axis such that said leg portion remains concealed, when viewed from directly above a club head body, within a range of adjustment of a lie angle for reasons similar to those discussed above. Therefore, the combination of Morrison, the alleged admission, Jackson and Chuzo fails to teach or suggest each of the elements of claim 6.

The failure of the combination of Morrison, the alleged admission, Jackson and Chuzo to teach or suggest each of the elements of claim 6 is fatal to the obviousness rejection. Therefore, claim 6 is not obvious over the prior art. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 6.

II. Miscellaneous

Applicant has amended claims 9-11. Applicant submits claims 9-11 have been amended for reasons unrelated to patentability.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that all of the currently pending claims 1-11 (11 total claims, 2 independent claims) properly set forth that which Applicants regard as their invention and are allowable over the cited prior art.

Accordingly, Applicants respectfully request reconsideration and allowance of all pending claims. The Examiner is invited to telephone the undersigned at (602) 382-6325 at the Examiner's convenience, if that would help further prosecution of the subject Application. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814, for which purpose a duplicate copy of this sheet is attached. This statement does NOT authorize charge of the issue fee.

Respectfully submitted,

Dated: 12/10/04

By: 

Daniel R. Pote, Reg. No. 43,011

SNELL & WILMER L.L.P.
400 E. Van Buren
One Arizona Center
Phoenix, Arizona 85004-2202
Phone: 602-382-6325
Fax: 602-382-6070